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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,571	09/23/2005	Jordi Tormo i Blasco	5000-0134PUS1	1311

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER	
LEESER, ERICH A	

ART UNIT	PAPER NUMBER
1624	

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/550,571	BLASCO ET AL.	
	Examiner	Art Unit	
	Erich A. Leeser	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7 and 8* is/are rejected.

7)☐ Claim(s) *6* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/23/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-8 are currently pending.

Priority

Acknowledgment is made of Applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/EP04/03346, filed on March 30, 2004.

Information Disclosure Statement

The references brought to the attention of the Examiner by Applicant are made of record.

Claim Objections

Claim 6 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim, claim 5 in this case. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

Claim Rejections – 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. "These aliphatic or alicyclic groups" in claim 1 does not particularly point out and distinctly claim the subject matter of the invention because these terms lack antecedent basis in that this term was not previously mentioned or defined as variables in the claim.

2. Claims 1-5 do not particularly point out and distinctly claim the subject matter of the invention because of the plural forms of the words, "7-(Alkynylamino)triazolopyrimidines" of claim 1 and "compounds" of claims 2-5. By reciting these terms in their plural form implies that they are compositions as opposed to a singular compound which is intended by the claim. It is suggested to Applicant to change "7-(Alkynylamino)triazolopyrimidines" of claim 1 to "7-(Alkynylamino)triazolopyrimidine" and "compounds" of claims 2-5 to "compound."

Claim Rejections 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 3-5 and 7-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pees et al., U.S. 5,965,561.

Pees et al. discloses pentafluorophenylazolopyrimidines that show fungicidal activity which include compounds, compositions and methods of use embraced in the instant claims. In particular, in compounds of formula I of the reference when R^1 is alkyl group and R^2 is an alkynyl group, then compounds taught by Pees et al. generically include the instant genus of compounds. However, as seen in Table 1, Pees et al. teaches R^1 = alkyl and R^2 = alkyl compounds. Pees et al. differs from the instant invention in not exemplifying R^2 = alkynyl compounds. However, Pees et al. teaches equivalency of exemplified R^2 = alkyl with various choices of R^2 including R^2 = alkynyl in the definition of R^2 for compounds of formula I.

Thus it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compounds using the teachings of Pees et al., including the alkynyl compound, and expect resulting compounds to possess the uses taught by the art in view of the equivalency teaching outlined above.

A similar argument could be made of Pees et al. (U.S. Patent Numbers 6,559,151; 6,297,251; 6,242,451; 5,817,663; 5,756,509; and 5,593,996); Aven et al. (U.S. Patent Number 6,124,301) and Pfrengle (U.S. Patent Number 5,981,534).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 and 7-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of Liu, United States Patent No. 6,559,151. Although the conflicting claims are not identical, they are not patentably distinct

from each other because the subject matter embraced in the instant claims are also embraced in United States Patent No. 6,559,151. The claims of the instant invention are the same as that of the reference when the reference's R^1 represents C_2-C_{10}-alkynyl and its R^2 represents hydrogen. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compounds using the teachings of Blasco and expect resulting compounds to possess the uses taught by the art in view of the teaching outlined above.

This obviousness-type double patenting rejection is not provisional because the conflicting claims have in fact been patented.

Claims 1-5 and 7-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 6, 7 and 8 of copending Application No. 10/513,030. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter embraced in the instant claims are also embraced in the copending Application No. 10/513,030. The claims of the instant invention are the same as that of the reference when the reference's R^1 represents C_2-C_{10}-alkynyl and its R^2 represents hydrogen. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compounds using the teachings of Blasco and expect resulting compounds to possess the uses taught by the art in view of the teaching outlined above.

Claims 1-5 and 7-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 9 and 10 of copending Application No. 10/523,719. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter embraced in the instant claims are

also embraced in the copending Application No. 10/523,719. The claims of the instant invention are the same as that of the reference when the reference's R^1 represents C_2-C_{10}-alkynyl and its R^2 represents hydrogen. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compounds using the teachings of Blasco and expect resulting compounds to possess the uses taught by the art in view of the teaching outlined above.

Claims 1-5 and 7-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 12-13, 18 and 19 of copending Application No. 10/508,409. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter embraced in the instant claims are also embraced in the copending Application No. 10/508,409. The claims of the instant invention are the same as that of the reference when the reference's R^1 represents C_2-C_8-alkynyl and its R^2 represents hydrogen. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compounds using the teachings of Blasco and expect resulting compounds to possess the uses taught by the art in view of the teaching outlined above.

Claims 1-5 and 7-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/483,597. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter embraced in the instant claims are also embraced in the copending Application No. 10/483,597. The claims of the instant invention are the same as that of the reference when the reference's R^1 represents C_2-C_{10}-alkynyl and its R^2 represents hydrogen. It would have been obvious to one having ordinary skill in the art at the

time of the invention was made to make compounds using the teachings of Blasco and expect resulting compounds to possess the uses taught by the art in view of the teaching outlined above.

Claims 1-5 and 7-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 10/483,599. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter embraced in the instant claims are also embraced in the copending Application No. 10/483,599. The claims of the instant invention are the same as that of the reference when the reference's R^1 represents C_2-C_{10}-alkynyl and its R^2 represents hydrogen. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compounds using the teachings of Blasco and expect resulting compounds to possess the uses taught by the art in view of the teaching outlined above.

Claims 1-5 and 7-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/483,600. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter embraced in the instant claims are also embraced in the copending Application No. 10/483,600. The claims of the instant invention are the same as that of the reference when the reference's R^1 represents C_2-C_{10}-alkynyl and its R^2 represents hydrogen. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compounds using the teachings of Blasco and expect resulting compounds to possess the uses taught by the art in view of the teaching outlined above.

Claims 2 and 3-4 are provisionally rejected under 35 U.S.C. § 103(a) as being unpatentable over Blasco et al., U.S. Application Number 10/474460.

Blasco discloses 5-Halogen-6-phenyl-7-fluroalkylamino-triazolo-pyrimidine which is the same as the instant compound of formula I.1 when the claimed invention's R^{21} is halomethyl, R^{22} is hydrogen and R^{23} is C_2-C_8-alkynyl when Blasco's R^1 is C_2-C_{10}-alkynyl, R^2 is hydrogen and R^3 is C_2-C_8-fluoroalkyl. The only legally significant difference between Blasco and the compound of formula I.1 of the claimed invention is the halomethyl of the claimed invention as compared to Blasco's C_2- fluoroalkyl. As such, the issue is how obvious was it at the time the invention was made to change Blasco's ethyl in to the claimed invention's methyl.

Motivation to modify the ethyl of the reference to the methyl of the claimed invention can be found in the specification at lines 25-26 of page 5 of the specification: "A preferred alkyl moiety is an ethyl or especially a methyl group."

Thus it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compounds using the teachings of Blasco, including the alkynyl compound, and expect resulting compounds to possess the uses taught by the art in view of this explicit teaching outlined above.

These latter obviousness-type double patenting rejections are provisional because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Erich A. Leeser whose telephone number is 571-272-9932. The Examiner can normally be reached Monday through Friday from 8:30 to 6:00 EST.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James Wilson can be reached at 571-272-0661. The fax number for the organization where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197. If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EL

Erich A. Leeser

Venkataraman Balasubramanian

VENKATARAMAN BALASUBRAMANIAN
PRIMARY EXAMINER